

REMARKS

Reconsideration of this application is respectfully requested in view of the above amendments and the following remarks.

The present invention relates to a freshening cosmetic composition comprising from about 0.01% to about 2% by weight menthol and from about 0.1% to about 10 % by weight menthyl lactate. The menthol/menthyl lactate ratio lies in the range of about 1/3 to about 1/10, and said composition is not irritating to sensitive parts of human skin.

Claims 1-17, 19-23 and 35-37 are pending. Claims 18 and 24-34 have been canceled.

Claims 4, 11, and 24-37 have been rejected under 35 U.S.C. §112, second paragraph, as indefinite. In claim 4, the Examiner objected to use of the phrase “SG 809 A.” This has been deleted. In claim 11, the Examiner objected to use of the phrase “in particular.” This has also been deleted.

Regarding claims 24-37, the Examiner notes that claim 24, from which claims 24-37 depend, recites, “consisting essentially of,” while some of claims 24-37 recite additional ingredients. Accordingly, claims 24-34 have been canceled. Claims 35, 36 and 37 do not recite additional ingredients, and have been maintained.

On the merits, claims 1-13, 15-17 and 19 stand rejected under 35 U.S.C. §102(b) as anticipated by US Patent No. 5,534,265 to Fowler et al. The Examiner suggests Fowler discloses a cleaning composition comprising 0.1 to 10% menthol and methyl lactate. The Examiner acknowledges that the claimed menthol/methyl lactate range of about 1/3 to about 1/10 is not disclosed in Fowler. However, the Examiner argues that a certain composition of Fowler would overlap of this range, since the amounts of menthol and methyl lactate overlap with the claimed amounts.

As set forth previously by Applicants, Fowler relates to a personal care composition containing insoluble micronized cleansing particles, a water soluble or dispersible gelling agent and water [Fowler et al., col. 2, l. 27-37]. In fact, Fowler merely sets forth a laundry list of materials from which menthol or menthyl lactate may be selected [Fowler et al., col. 19, l. 37-43]. There is no teaching or suggestion that they may or should be used together as a combination. Fowler mentions literally dozens of compounds that may be present in the described compositions. This does not amount to a

suggestion, let alone an express teaching of the use of two particular compounds in particular amounts and in a particular ratio. The Examiner acknowledges as much regarding the ratio. Applicants therefore respectfully request reconsideration of this rejection.

Similarly, claims 1-3, 15-17 and 21-23 stand rejected under 35 U.S.C. §102(b) as anticipated by JP 10,231,238 to Koga. The Examiner states Koga teaches a cosmetic composition prepared by adding 0.001 – 10.0 weight percent of menthol and at least one of menthol lactate, menthol glycoside, menthol hydroxybutyrate, methoxypropanediol and menthoxyfurane. Again, the Examiner contends that the amounts of menthol and methyl lactate recited in Koga generally fall within the amounts claimed by applicants, and therefore a composition within Koga has the claimed ratio of menthol to menthol lactate.

Applicants again disagree. Koga relates to compositions that “have a refreshing feeling and an excellent capacity for that feeling to be sustained by compounding a refrigerant and then compounding ethanol and isopropyl alcohol with it.” [Koga, ¶0003] Koga achieves its results by utilizing refrigerants such as menthol or menthol lactate, but not necessarily both together and not necessarily in the ratios presently claimed. Furthermore, Koga teaches that such refrigerants should be used in combination with ethanol and isopropyl alcohol. It neither recognizes nor solves the problem addressed by the compositions of applicants’ invention, i.e., that menthol and menthol lactate may be combined in order to produce refreshment without annoying or irritation to sensitive skin. Koga’s compositions, where they contain both menthol and menthol lactate, all contain considerably more menthol than menthol lactate. Nowhere does Koga teach or suggest the use of menthol and menthol lactate in ratios wherein there is considerably less menthol than menthol lactate (1:3 to 1:10 as opposed to 2:1 or 3:1, as set forth in Koga’s Examples). Moreover, Koga’s examples set forth concentrations of menthol that are higher than those contemplated by the compositions of applicants’ invention (0.2% or 0.3% compared with 0.08% to 0.12%) and menthol lactate concentrations lower than those of applicants’ invention (0.1% compared with 0.45% to 0.55%).

Accordingly, the rejection over Koga under Section 102(b) is without merit. The particular combination claimed, including specific amounts and ratios, is not found in Koga. Applicants request withdrawal of this rejection.

Finally, claims 14, 18 and 20 have been rejected under 35 U.S.C. §103(a) as obvious over Fowler. The Examiner argues that it is within the purview of one skilled in the art to formulate compositions having the amounts specified in these claims.

Applicants disagree. Fowler does not teach or suggest the basic idea behind the invention -- the specific combination of menthol and methyl lactate, in recited amounts and ratios -- let alone further combination of this with other ingredients in specific amounts. Applicants respectfully request reconsideration of the rejection under Section 103(a).

Each of the rejections set forth in the present Office Action are in reality based on an "obvious to try" standard, which of course is impermissible. The specific combination claimed by applicants, including amounts and ratios, is not found in the references. Applicants therefore request withdrawal of the pending rejections and allowance of this application.

Respectfully submitted,

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